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Application Number	10/036,815
Filing Date	October 19, 2001
First Named Inventor	Wayne E. Fisher
Art Unit	2163
Examiner Name	Uyen T. Le
Attorney Docket Number	39802-P005US

Total Number of Pages in This Submission

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Date	March 8, 2007	Reg. No.	34,763

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s):	Fisher, Wayne E.		
Assignee:	NEON Enterprise Software, Inc.		
Title:	Ensuring That A Database And Its Description Are Synchronized		
Serial No.:	10/036,815	Filing Date:	October 19, 2001
Examiner:	Uyen T. Le	Group Art Unit:	2163
Docket No.:	39802-P005US (f/k/a M-11460 US)	Confirmation No.:	4940

Dallas, Texas
March 8, 2007

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APPELLANT'S REPLY BRIEF

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated January 8, 2007, with a two-month statutory period for response set to expire on March 8, 2007.

I.   RESPONSE TO EXAMINER'S ARGUMENTS

A.   Claims 1-18 comply with 35 U.S.C. § 112, First Paragraph

Appellant appreciates the Examiner withdrawing the rejection of claims 1-18 under 35 U.S.C. § 112, first paragraph.

B.   Response to Examiner's Assertion that Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ahmad*

As discussed in Appellant's Appeal Brief, the present invention relates to a method of verifying that the correct IMS control blocks are used when processing an IMS database. The Data Management Block (DMB) is the control block which IMS uses to manage the loading of user data into an IMS database. It is also the control block used to subsequently process the database. It is the user's responsibility to provide the DMB for IMS to use. IMS has no way of knowing if the DMB used to create the database is identical to the DMB which should be used to subsequently process the database. If they are different (i.e., <u>not</u> synchronized), the integrity of the database is at risk. *See* Specification, P. 18, line 27 - P. 20, line 15. The description of the database, referred to as the Database Description (DBD), is stored in the DMB. Appellant's claimed invention is directed to a method of storing a copy of the DBD in an IMS database to ensure that the IMS database and the description for said IMS database are synchronized. In particular, the copy of the DBD in the database is compared to the DBD maintained in the DMB control block to ensure that they are synchronized; if they are not synchronized, subsequent processing of the database could cause database integrity problems.

On the other hand, *Ahmad* describes a system and method for adapting data access client and server programs to enable an application program on a local computer (e.g., a PC) to access data (such as IMS database data) residing on a remote computer (e.g., a mainframe). In order to accomplish this

in the case of IMS database data, a user selects and downloads copies to the PC of DBDs for the remote IMS data files to be accessed by the PC-based application program. The user may need to add, change, delete, or modify items in a DBD cross-reference table to establish an appropriate cross-reference to the remote IMS data file to be accessed. *See* Abstract, Col. 6, lines 23-26 and Col. 12, line 41 to Col. 13, line 9. *Ahmad* does <u>not</u> teach, however, storing a copy of a DBD in an IMS database to be accessed. *Ahmad* also does <u>not</u> teach comparing the copy of the DBD in the database to the DBD in the DMB control block.

The Examiner rejected claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over *Ahmad*. Appellant respectfully submits that the Examiner has not met the Examiner's burden of factually supporting a *prima facie* conclusion of obviousness.

It is the Examiner's burden to factually support any *prima facie* conclusion of obviousness. The Examiner's duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of <u>facts gleaned from the prior art</u>. *See* MPEP §§ 2141-2144.

In a recent decision from the United States Court of Appeals for the Federal Circuit, the Federal Circuit noted that when the patent examiner and Board "rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record." *In re Sang-Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Specifically, the Federal Circuit noted that conclusory and subjective opinions about what is "basic knowledge" or "common sense" by themselves do not adequately support a determination of unpatentability. *See Id.* at 1343-44. Thus, the Federal Circuit held that findings of obviousness based on "common knowledge" must be supported by documented evidence that such knowledge exists. *See Id.* at 1344-45.

The Examiner admits that *Ahmad* does not teach several elements of the pending claims. In

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the office actions as well as in the Examiner's Answer, the Examiner continues to only offer conclusory and subjective opinions that these claim elements not taught by *Ahmad* would have been "obvious" or "well-known." The Examiner has not supported such statements with documented evidence, as he was required to do. Accordingly, the claims rejected under § 103 are allowable over *Ahmad* for at least this reason.

Furthermore, the Examiner has not provided proper evidence that *Ahmad* teaches at least two fundamental limitations of Appellant's claims: (1) storing a copy of said database description for said IMS database within the database (*see* claim 1); and (2) comparing the copy of the description in the database to the description stored in the data management control block (*see* claim 1). The Examiner also admits that *Ahmad* does not teach other of the claimed elements.

The Examiner acknowledges that *Ahmad* does <u>not</u> show the DBD information being stored in an IMS database as one or more database records. However, the Examiner argues, without any documentary evidence or cites to *Ahmad,* that because DBDs have to be stored in a computer, and they are less than 40 Kilobytes in size, and there are good reasons to store the DBD in a database, it would have been obvious to so do. This is exactly the type of hindsight that the law considers to be impermissible.

The Examiner also does <u>not</u> adequately address the fact that Appellant's claims provide for comparing the copy of the DBD in the database with the DBD in the data management control block (DMB). The Examiner argues that *Ahmad* teaches comparing DBD copies, but the cite to *Ahmad* provided by the Examiner in the Answer (col 12, lines 41-48) clearly does not teach such comparing, and, more specifically, it does not teach comparing a copy maintained in the database to the original DBD maintained in the data management control block.

Thus, these are additional significant reasons that independent claim 1 and dependent claims

2-18 are patentable over *Ahmad*.

II.   CONCLUSION

For the above reasons and the reasons stated in Appellant's Appeal Brief, Appellant respectfully submits that rejection of pending Claims 1-18 is unfounded. Accordingly, Appellant requests that the rejection of Claims 1-18 be reversed.

This Reply Brief is submitted in triplicate.

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 1.8

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